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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,127	01/18/2006	Robert H. Wohleb	090238-00178	7811
30993 7590 10/06/2011 CRAIN, CATON & JAMES FIVE HOUSTON CENTER 1401 MCKINNEY, 17TH FLOOR HOUSTON, TX 77010				
EXAMINER LUDLOW, JAN M				
ART UNIT		PAPER NUMBER		
1773				
NOTIFICATION DATE		DELIVERY MODE		
10/06/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/565,127

Applicant(s)

WOHLEB, ROBERT H.

Examiner

JAN LUDLOW

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-4,8,9,15-18,21,22,26-30,35-37 and 42-47 is/are pending in the application.

5a) Of the above claim(s) ____ is/are withdrawn from consideration.

- 6) ☐ Claim(s) ____ is/are allowed.

- 7) ☒ Claim(s) 1-4,8,9,15-18,21,22,26-30,35-37 and 42-47 is/are rejected.

- 8) ☐ Claim(s) ____ is/are objected to.

- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 1/18/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 11, 2010 has been entered.

2. Claims 1-4, 8-9, 15-18, 21-22, 26-30, 35-37, 42-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for the negative limitation "immovably fixed". While the disclosure does not describe moving the inner surface 310 (which is shown as a separate structure from the cap) relative to the cap, neither does it describe that it cannot be moved relative to the cap, e.g., removed as by prying.

1. The amendment filed March 11, 2011 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as described above. Applicant is required to cancel the new matter in the reply to this Office Action.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-4, 15-18, 26-27, 29-30, 35, 45, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth.

Forsyth teach a vessel 6 with neck and opening capped by cap 3A, 4A having porous sorbent coated surface 1A. (col. 3, lines 36-60; Figures 3-4). The cap is applied to the vessel, analyte extracted, the coating portion withdrawn into a tube within the cavity of the cap, the cap removed and the fiber placed in a second vial for extraction prior to injection into an analyzer (col. 4, lines 5-37). It is the examiner's position that the Teflon seal is penetrable within the crimp cap as was known in the art. Forsyth further teaches:

If a shielded fibre assembly (FIG. 3) is used, the support material extends through the vial seal. (col. 4, lines 10-11).

If a shielded fibre is used (FIG. 3), the coating is retracted into the stainless steel tubing by pulling the cylindrical support 1A(FIG. 3) into the tube before opening the vial. (col. 4, lines 28-31).

If the fibre is pulled up through the silicone septum, until the fibre coating is inside the stainless steel sleeve 3, the extracted analytes are shielded from volatilizing into the atmosphere. (col. 3, lines 24-27).

Forsyth fails to explicitly teach the coated surface immovably fixed to the cap or the Teflon seal as a stopper (i.e., a cap having a sidewall within the neck of the vessel), or recapping the first vessel and capping the second.

It would have been obvious to provide the fiber fixed to the cap if one were willing to forego the advantages of using the shield, as suggested by Forsyth in stating "If a shielded fiber is used...." If a shielded fiber is not used, the fiber does not extend through the vial seal 4A as shown in Figure 4, and it would have been obvious to provide the fiber fixed to the seal so that it does not fall into the vessel, which is immovably fixed to the cap when the cap is sealed to the vial.

It would have been obvious to provide the Teflon seal of Forsyth in the form of a stopper as an alternative known sealing member for a crimp or screw top vial as was known in the art.

It would have been further obvious to provide a second cap on the first vessel in order to preserve for future testing and/or prevent spillage as was known in the art. It would have been obvious to provide the entirety of the first cap to the second vial in order to completely and/or partially seal it during the second extraction process so as to prevent evaporation and/or contamination as was known in the art.

5. Claims 8-9, 15, 21-22, 28, 36-37, 42-44, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth as applied to claims above, and further in view of Pawliszyn (2002/0178797).

Forsyth fails to teach a particulate coating.

Pawliszyn teaches a device similar to that of Forsyth. The fiber can be coated with particulate [0080].

It would have been obvious to coat the fiber of Forsyth with particulate in order to sorb analytes as taught by Pawliszyn.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rits additionally teaches a coated cap with sorbent and penetrable port.

7. Applicant's arguments filed March 11, 2011 have been fully considered but they are not persuasive.

8. There was no pending rejection over Lee.

9. Applicant argues that Forsyth does not teach a coating applied to a top cover interior surface immovably fixed within the cap, but the instant claim language is "immovably fixed to said cap".

Applicant argues that Forsyth teaches that the fiber with the coating is movable with respect to the cap, but Forsyth further teaches:

If a shielded fibre assembly (FIG. 3) is used, the support material extends through the vial seal. (col. 4, lines 10-11).

If a shielded fibre is used (FIG. 3), the coating is retracted into the stainless steel tubing by pulling the cylindrical support 1A(FIG. 3) into the tube before opening the vial. (col. 4, lines 28-31).

If the fibre is pulled up through the silicone septum, until the fibre coating is inside the stainless steel sleeve 3, the extracted analytes are shielded from volatilizing into the atmosphere. (col. 3, lines 24-27).

It would have been obvious to provide the fiber fixed to the cap if one were willing to forego the advantages of using the shield, as suggested by Forsyth in stating "*If a shielded fiber is used....*" If a shielded fiber is not used, the fiber does not extend through the vial seal 4A as shown in Figure 4, and it would have been obvious to provide the fiber fixed to the seal so that it does not fall into the vessel, which is immovably fixed to the cap when the cap is sealed to the vial.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAN LUDLOW whose telephone number is (571)272-1260. The examiner can normally be reached on Monday, Tuesday and Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jan M. Ludlow
Primary Examiner
Art Unit 1773

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Primary Examiner, Art Unit 1773